

REMARKS

Applicants and Applicants' attorney express appreciation to the Examiner for the courtesies extended during the recent interview held on October 7, 2004. The amendments and arguments presented in this paper are consistent with the proposed amendments and arguments discussed during the Interview.

Claims 1-7, 9-35, and 37-39 are pending, of which claims 1, 21, 26, and 30 are independent method claims, with independent computer program product claim 24 corresponding to independent method claim 1. As indicated above, claims 8 and 36 have been canceled without prejudice and claims 1, 15, 16, 21, 24, 30, 31, and 37 have been amended by this paper.

The Office Action rejected claims 15 and 16 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention because the term "some" in claim 15 is a relative term. In response, Applicants note that "[t]he test for definiteness under 35 U.S.C. 112, second paragraph, is whether 'those skilled in the art would understand what is claimed when the claim is read in light of the specification.'" MPEP § 2173.02. Applicants further note that "Office policy is not to employ *per se* rules to make technical rejections." *Id.* Moreover, with respect to relative terminology in particular, "[t]he fact that claim language, including terms of degree, may be not precise, does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph." MPEP § 2173.05(b) ("Relative Terminology"). To the contrary, as explained above, "[a]cceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification." *Id.*

Applicants respectfully submit that one of ordinary skill in the art would understand that use of the phrase "only some" in claim 15, especially when read in light of paragraphs [0062]-[0063] of the specification, simply indicates that not all (i.e., only a portion) of the one or more language expressions associated with the first instant message are displayed, and therefore one of ordinary skill in the art would in fact understand what is claimed when claim 15 is read in light of the specification. Accordingly, based on at least the foregoing reasons, the rejection of claim 15 under 35 U.S.C. § 112, second paragraph, as being indefinite, is improper and should be withdrawn. Should the Examiner maintain this rejection, Applicant respectfully request that the next Office Action provide an analysis as to why the phrase "only some" is vague and indefinite. MPEP § 2173.02. Because claim 16 has been amended by this paper to depend from claim 1, the rejection of claim 16 under 35 U.S.C. § 112, second paragraph, as being indefinite, is now moot.

The Office Action rejected claims 1-7, 9-15, 17-20, 24-25, and 27-29 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,519,771 to Zenith ("*Zenith*"), rejected claims 30-32, 34-35, and 38-39 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,584,494 to Manabe et al. ("*Manabe*"), rejected claims 8, 16, and 26-29 under 35 U.S.C. § 103(a) as being unpatentable over *Zenith*, rejected claims 21-23 under 35 U.S.C. § 103(a) as being unpatentable over *Zenith* in view of *Manabe*, rejected claims 33 under 35 U.S.C. § 103(a) as being unpatentable over *Manabe*, and rejected claims 36-37 under 35 U.S.C. § 103(a) as unpatentable over *Manabe* in view of *Zenith*.¹

As indicated above, the subject matter of dependent method claim 8 has been incorporated into independent method claim 1; dependent method claim 21 has been rewritten in independent form to include the limitation of independent method claim 1; the subject matter of

¹Applicants do not acquiesce the prior art status or asserted teachings of the cited art, and specifically reserve the right to challenge those asserted teaching and/or the prior art status of the cited art in the future.

dependent method claim 16 has been incorporated into independent computer program product claim 24; and the subject matter of dependent method claim 36 has been incorporated into independent method claim 30. Accordingly, based on the rejections identified in the Office Action and summarized above, each of the pending independent claims (1, 21, 24, 26, and 30) as amended should be subject to rejection under 35 U.S.C. § 103(a) as either being unpatentable over *Zenith* or as being unpatentable over *Zenith* in view of *Manabe*.

However, Application No. 09/867,944 (this application), and U.S. Patent No. 6,519,771 to *Zenith* were, at the time the invention of Application No. 09/867,944 owned by or subject to an obligation of assignment to WebTV Networks, Inc., a wholly owned subsidiary of Microsoft Corporation. Therefore, in accordance with 35 U.S.C. § 103(c), *Zenith* is disqualified as 35 U.S.C. § 102(e) prior art.² (Applicants filed on May 30, 2001, which is on or after November 29, 1999, and *Zenith* issued February 11, 2003.) See MPEP § 702.02(I). Accordingly, the rejections of record under 35 U.S.C. § 103(a) for each of the pending independent claims (1, 21, 24, 26, and 30), and thus for all currently pending claims, should be withdrawn.

Based on at least the foregoing reasons, therefore, Applicants respectfully submit that the cited art fails to anticipate or make obvious Applicants' invention, as claimed, for example, in independent claims 1, 21, 26, 24, and 30. Applicants note for the record that the other rejections and assertions of record with respect to the independent and dependent claims are now moot, and therefore need not be addressed individually. Accordingly, Applicants do not acquiesce to any assertions in the Office Action that are not specifically addressed above, and hereby reserve the right to challenge those assertions in the future, if necessary or desired.

²In disqualifying *Zenith*, Applicants do not acquiesce to any of the teachings of *Zenith* that are asserted in the Office Action—it is simply unnecessary to address those assertions at this time. However, as indicated above, Applicants reserve the right to challenge any of the Office Action's assertions in the future, should such challenges become necessary or desirable.

In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 2nd day of December, 2004.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Rick D. Nydegger", with a stylized flourish at the end.

RICK D. NYDEGGER
Registration No. 28,651
ERIC M. KAMERATH
Registration No. 46,081
Attorneys for Applicant

Customer No. 022913